APPENDIX 1

RELEVANT STATUTES AND RULES

35 USC § 6 Duties of Commissioner

The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trade-marks; and he shall have charge of property belonging to the Patent Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

35 USC § 135 Interferences

(a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Federal Rules of Civil Procedure, Rule 52.

FINDINGS BY THE COURT

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusions of law thereon, and judgment shall be entered pursuant to Rule 58; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b).

Patent Office Rule 256(b)

(b) Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Patent Interferences so states. Any reply thereto must be filed within fifteen days from the filing of the petition. (See rule 304.)

APPENDIX 2

EXCERPT FROM PETITIONERS' BRIEF BEFORE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Patent Appeal Docket No. 8978

SILVESTRI, ET AL.,
Appellants,
v.
GRANT, ET AL.,
Appellees.

Appeal From the Board of Patent Interferences
(Interference No. 94,856)

APPELLEES' BRIEF

* * * * *

Assuming Arguendo an Actual Reduction to Practice, Silvestri Abandoned, Suppressed or Concealed the Invention and Was Spurred Into Activity Only Upon Seeing the Grant Patent Issue in August of 1964

Although Grant respectfully submits that Silvestri has utterly failed to establish beyond a reasonable doubt an actual reduction to practice in 1962 as alleged by Silvestri, the record makes it abundantly clear that *if* Silvestri

can be regarded as having proved an actual reduction to practice at that time, he abandoned, suppressed or concealed it and did not revive any interest in it until spurred into activity by the issuance of the Grant patent in August of 1964.

Thus, if it be assumed *arguendo* that Silvestri was in possession of the invention in the spring or summer of 1962, why then did Silvestri fail to *disclose* that invention in his parent application filed in October of 1962? The answer seems obvious; he either was not aware of it or he abandoned, suppressed or concealed it. A rather strong presumption adverse to Silvestri arises from his failure to disclose the invention in his parent application of October 1962. See *Ellis* v. *Scott et al*, 43 App. D.C. 441 (1915).

If Silvestri was in possession of the invention in the spring or summer of 1962, why was it when he filed his new drug application that he *intended* that the new drug application should be for the *trihydrate*, as admitted by Dr. Frediani (R. 1129, Q 81-83). The answer seems obvious. The answer *is* obvious: Silvestri simply was not in possession of the invention in 1962, or else he abandoned, suppressed or concealed it. So far as the record shows, were it not for the issuance of Grant's patent the invention defined by the count would be lost to the world.

If Silvestri was in possession of the invention defined by the count in the spring or summer of 1962, why is it that the invention record or invention disclosure submitted to the assignee by the inventors (Grant's Cross-Exhibit 1) was completely silent concerning that invention? See Dr. Johnson's admission at R. 201, X Q 177. It was conceded that there was no separate invention record for the later Silvestri II application directly involved in this interference (R. 190-1). The only logical inference is that Silvestri simply was not in possession

of the invention at that time or that he had abandoned it.

When the Grant patent issued in August of 1964, it came to Dr. Johnson's attention some time shortly thereafter, perhaps a month later. Dr. Johnson admitted on cross-examination that he assumed he first saw the Grant patent "fairly soon" after its issue date (R. 164-5, X Q 60-61) and probably in September of 1964 (R. 165, Q 65).

On this clear suggestion of spurring into activity, the answers to written interrogatories of Richard H. Brink, one of the attorneys for Silvestri, are also highly pertinent (R. 1207-10). Mr. Brink admitted that he first became aware of the issuance of the Grant patent at some indeterminate date "probably within one or two months after the issuance of that patent" (Inter. No. 7). (R. 1208). He admitted further that he had conducted a factual investigation of data resulting from or based upon work done at Bristol Laboratories to locate infrared traces allegedly corresponding to the infrared trace which is Fig. 1 of the Grant patent and that he began that factual investigation at some indeterminate date soon after he became aware of the patent (Inter. 8 and 9) (R. 1208). His initial investigation was completed some time *prior* to the filing of the Silvestri II application on November 2, 1964 (Inter. 10). (R. 1208) Mr. Brink admitted that so far as he was aware *no one else* had ever made a factual investigation of the kind just indicated independent of his own investigation (Inter. 14). (R. 1209). It appears from Mr. Brink's answer to Inter. 16 that he was responsible for preparing and filing the Silvestri II application of 1964. (R. 1209). From his answer to Inter. 19, R. 1209, it appears that it was Mr. Brink who retrieved the I R curves for various materials, including 12 CD 61, that had lain buried in the Bristol Laboratory files, and with Mr. Joseph Bomstein

determined or confirmed the alleged fact that the I R trace for 12 CD 61 was substantially identical to the I R trace of Fig. 1 of the Grant patent."

A stronger showing of a spurring into activity would be hard to imagine. The classic doctrine of *Mason* v. *Hepburn*, 13 App. D.C. 86 (1898), clearly applies. See also the more recent cases of *Woofter* v. *Carlson*, 54 CCPA 917, 367 F.2d 436 (1966) and *Engelhardt* v. *Judd et al*, 54 CCPA 865, 369 F.2d 408 (1966).

Also of great interest is the old case of *Halbleib* v. *Bendix et al*, 50 App. D.C. 247 (1921), for the reason that there the time period of spurring into activity between the successful test by one Bijur of his device ("the early part of 1912") and the time when Bijur "made any attempt to *resurrect* or commercialize his device" after seeing Bendix's device at an automobile show ("in January and February, 1914") is of the same order of magnitude as the corresponding time period here, which is from the spring or summer of 1962 to or shortly after August of 1964 when Grant's patent issued.

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[10] These facts loom up with especial significance when it is recalled that one of Silvestri's star witnesses (Donald Marquette who at the time was project supervisor in the pilot plant—R.208, Q. 17) admitted when called as a witness by Grant that the procedure of Dr. Johnson's memorandum of April 2, 1962 (SE 5) was not carried out after approximately the Fall of 1962 (R. 1152, Q. 29). This admitted cessation of activity in the Fall of 1962 in respect of the boasted procedure of Dr. Johnson assumes added significance when measured against the admission of Dr. Johnson (and a different co-applicant) made in his later-filed patent No. 3,157,640 (SE 4) at column 1, lines 53-60:

> "However, due to the fact that anhydrous (D-(—)-*α*-aminobenzylpencillin is soluble in water to the extent of about 20-25 mg./ml. at 20-25° C., it is very difficult to recover the product in high yields. Furthermore, the recovered (D-(—)-*α*-aminobenzylpencillin may be obtained in the form of a monohydrate. The monohydrates (as well as the dihydrates) of D-(—)-*α*-aminobenzylpencillin possess poor biological stability."

It is true that—even assuming *arguendo* an actual reduction to practice by Silvestri in 1962—Grant sustained his burden of proving by at least the preponderance of the evidence Silvestri's abandonment, suppression or concealment of the invention defined by the count (plus spurring into activity by and shortly after the issuance of Grant's patent) solely from the examination or cross-examination of witnesses produced by or on behalf of *Silvestri*. But, as was stated by Mr. Chief Justice Taft for the Supreme Court of the United States in *Eibel Process Co.* v. *Minnesota & Ontario Paper Co.*, 261 U.S. 45 at 53 (1923): "A case that can be made out in all its elements by cross-examination of opposing witnesses is a strong case."

* * * * *

Respectfully submitted,

VITO VICTOR BELLINO
ANDREW KAFKO
ELLSWORTH H. MOSHER
Attorneys for the Appellees

December 1972

APPENDIX 3

EXCERPT FROM REPLY BY GRANT et al. TO THE SILVESTRI et al. MOTION TO VACATE AND REMAND

IN THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Patent Appeal Docket No. 8978

SILVESTRI, ET AL.,
Appellants

v.

GRANT, ET AL.,
Appellees

REPLY BY GRANT ET AL TO THE SILVESTRI ET AL OPPOSITION TO THE GRANT ET AL MOTION TO VACATE AND REMAND

* * * * *

Grant agrees with Silvestri that the question of abandonment, suppression or concealment is "an *ultimate* conclusion of law". Nevertheless that ultimate conclusion of law cannot rationally be arrived at *in a vacuum*. It must be based on relevant findings of fact. It is Grant's position that under the law such findings of fact should have been made *in the first instance* by the Board of Patent Interferences and not by this Court.

* * * * *

Respectfully submitted,

Of Counsel:
JOSEPH SCHIMMEL

August 8, 1974

VITO VICTOR BELLINO
ANDREW KAFKO
ELLSWORTH H. MOSHER
Attorneys for the Appellees

By Ellsworth H. Mosher
ELLSWORTH H. MOSHER

APPENDIX 4

REASONS FOR APPEAL

IN THE UNITED STATES PATENT OFFICE

Interference No. 94,856

SILVESTRI ET AL

v.

GRANT ET AL

NOTICE OF APPEAL TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS AND REASONS OF APPEAL

Honorable Commissioner of Patents
Washington, D.C. 20231

Sir:

Now comes Silvestri et al, the junior party, by their attorney, and give notice to the Commissioner of Patents, pursuant to Rules 301 and 302 of the Rules of Practice, of their appeal to the United States Court of Customs and Patent Appeals from the decision of the Board of Patent Interferences rendered on January 15, 1971, awarding priority of invention of the count in issue to the senior party, Grant et al, in the above-entitled case.

The reasons of appeal are as follows:

1. The Board erred in awarding priority of invention of the subject matter of the count in issue to the senior party, Grant et al.

2. The Board erred in not awarding priority of invention of said subject matter to the junior party, Silvestri et al.

3. The Board erred in holding that the party Silvestri et al was not entitled to the filing date, October 29, 1962, of their parent application Serial No. 233,943.

4. The Board erred in holding that the parent Silvestri application Serial No. 233,943 does not disclose the subject matter of the count.

5. The Board erred in affirming the Primary Examiner's holding that the parent Silvestri et al application, Patent No. 3,180,862, does not disclose the subject matter of the count.

6. The Board erred in holding that the involved Silvestri application contains much new matter as compared with the parent application.

7. The Board erred in holding that Johnson did not testify that the product of Example 13 of SE 2 was made by the method described in SE 5.

8. The Board erred in implying that disclosure of acylation of 6-APA with phenylglycyl chloride HCl is necessary in the parent Silvestri application to establish inherent production of the compound of the count.

9. The Board erred in holding that no correlation has been established between SE 2 and SE 5.

10. The Board erred in its interpretation of the decisions *Smith* v. *Wehn*, 50 CCPA 1554, 318 F2d 325, 136 USPQ 52; *Dreyfus et al* v. *Sternau*, 53 CCPA 1050, 357 F2d 411, 149 USPQ 63; *In re Nathan*, 51 CCPA 1059, 328 F2d 1005, 140 USPQ 601; and *Petisi et al* v. *Rennhard et al*, 53 CCPA 1452, 363 F2d 903, 150 USPQ 669, and particularly in the requirements for inherency.

11. The Board erred in holding that the invention of the count was not sufficiently identified or recognized in the parent Silvestri et al application.

12. The Board erred in not holding that the parent Silvestri application Serial No. 233,943 does inherently disclose the subject matter of the count.

13. The Board erred in finding that parent application Serial No. 233,943 of Silvestri et al does not constitute a constructive reduction to practice of the subject matter of the count.

14. The Board erred in deciding that the party Silvestri et al is not entitled to the benefit of the filing date October 29, 1962 of their parent application Serial No. 233,943 as a constructive reduction to practice of the subject matter of the count.

15. The Board erred in not finding that Examples 1 and 2 of Serial No. 233,943 produced the product of the count.

16. The Board erred in not finding the characteristics of the product of the count where inherent in the product of Examples 1 and 2 of Serial No. 233,943.

17. The Board erred in not finding that the physical properties defined in the count, i.e., crystalline state, water content, molecular weight, infrared absorbtion spectrum and storage stability, are inherent characteristics of the compound of the count and specific recitation of these properties in the Silvestri et al parent application is not necessary for a disclosure of the compound defined by the count.

18. The Board erred in failing to find that the process described in the parent application of Silvestri et al Serial No. 233,943 and Examples 1 and 2 of said application inherently produce the compound of the count.

19. The Board erred in stating on page 13 of its decision that the Silvestri parent application clearly does disclose the product of the count.

20. The Board erred in holding that the record for Silvestri et al failed to establish beyond a reasonable doubt, conception of the invention of the count prior to December 29, 1962, the record date of Grant et al.

21. The Board erred in not holding that the record for Silvestri et al did establish beyond a reasonable doubt, conception of the invention of the count prior to December 26, 1962.

22. The Board erred in finding no reference to nor recognition by Silvestri et al of the product of the count in SE 5.

23. The Board erred in failing to find any evidence or recognition or conception of the count by Silvestri et al prior to December 26, 1962, the record date of Grant et al.

24. The Board erred in its interpretation of the decision in *Heard* v. *Burton et al*, 51 CCPA 1502, 333 F2d 239, 142 USPQ 97.

25. The Board erred in holding that since Silvestri et al had no conception of the invention prior to Grants' record date, on this ground alone Silvestri et al cannot prevail.

26. The Board erred in holding that the record for Silvestri et al failed to establish, beyond a reasonable doubt, actual reduction to practice of the invention of the count prior to December 29, 1962, the record date of Grant et al.

27. The Board erred in not holding that the record for Silvestri et al established, beyond a reasonable doubt, actual reduction to practice of the invention of the count prior to December 26, 1962.

28. The Board erred in stating that the record for Silvestri et al does not establish an actual reduction to

practice of the invention of the count beyond a reasonable doubt.

29. The Board erred in implying that the procedure outlined in memorandum SE 5 involved only the acylation of 6-APA with D-phenylglycyl chloride HCl.

30. The Board erred in stating that the product obtained by the acylation of 6-APA with D-phenylglycyl chloride HCl was referred to at Bristol as "P 50".

31. The Board erred in stating that in answer to interrogatories by counsel for Grant, Brink, the attorney of record for Silvestri stated that he first made the factual determination that Silvestri and Johnson, the co-inventors had performed work, either themselves or others on their behalf, that allegedly constituted the invention claimed, soon after the involved Grant patent issued.

32. The Board erred in stating that the investigation leading up to the factual determination was made by Brink several months prior to the filing date of the involved Grant patent.

33. The Board erred in finding that Johnson's testimony that 12 CD 61 "would probably be free of bound water" required corroboration and was not corroborated.

34. The Board erred in not finding that Run Nos. 80C P50, 82AA P50, 85A P50, 90A P50, 94A P50, 104 P50, 105 P50 and 122 P50, and the testing of the compound obtained, each constituted a reduction to practice of the invention of the count by Silvestri et al.

35. The Board erred in not finding that the products identified as 12 CD 57, 12 CD 61, 12 CD 63, 12 CD 71, 12 CD 82, 12 CD 100, 12 CD 106, 12 CD 107, 12 CD 131 and K2036 were established by Silvestri et al to have the characteristics of the compound of the count.

36. The Board erred in not finding that the form of anhydrous D-α-aminobenzylpenicillin of the count is dis-

tinguished from the form of anhydrous D-α-aminobenzylpenicillin which is the subject matter of U.S. 3,472,841 by its distinctive infrared spectrum.

37. The Board erred in not finding that Mr. Hull and Dr. Pollak recognized from the infrared spectrographs that a new form of anhydrous ampicillin had been prepared.

38. The Board erred in relying on the testimony of Mr. Marquette to explain a notation made by the person who performed the infrared analysis on 12 CD 61.

39. The Board erred in implying that there was any need for Johnson to testify "on the nature of the available standard".

40. The Board erred in misinterpreting Hull's testimony regarding an I.R. standard and in ignoring Hull's and Pollak's testimony relating to a comparison of infrared spectographs which they ran to a standard.

41. The Board erred in considering the contemporaneous conclusions of Bomstein while ignoring the contemporaneous conclusions of Hull and Pollak.

42. The Board erred in not holding that Bomstein's testimony did establish that the I.R. curves of lots such as 12 CD 57, 12 CD 61 and 12 CD 63 were the same as Figure 1 of the Silvestri et al application.

43. The Board erred in stating that they find no progress reports at Bristol directed to the invention of the count while ignoring contemporaneous documentary evidence which is of record.

44. The Board erred in finding that there was no evidence in the record of Silvestri et al to establish the preparation and identification of the compound of the count, the testing of said compound for utility, nor corroboration of preparation, identification and utility testing prior to the record date of Grant et al.

45. The Board erred in failing to find that testing of the compound of the count is unnecessary, since the utility is obvious.

46. The Board erred in failing to find that the utility of the compound of the count was established by Silvestri et al by testing the compound against *Staphylococcus aureus*.

47. The Board erred in holding that the compounds tested against *Staphylococcus aureus* were not established by Silvestri et al to be the compound of the count "but rather P 50".

48. The Board erred in failing to find that the analytical work done by various personnel at Bristol inures to the benefit of Silvestri et al.

49. The Board erred in failing to find that the samples of Form II ampicillin sent to the FDA correspond to the compound of the count.

50. The Board erred in failing to find that the certificates of analyses and the Finished Product Specifications submitted to the FDA all described the compound of the count and are evidence of a conception and a reduction to practice of the invention of the count.

51. The Board erred in stating that the appearance of the involved Grant patent on the scene was the spur that led to or catalyzed the filing of the involved Silvestri application.

52. The Board erred in holding that Silvestri is entitled only to the filing date of the involved Silvestri

application; namely, November 2, 1964 for conception and reduction to practice.

Respectfully submitted,

Richard H. Brink
Attorney for Silvestri et al

Of Counsel:

Robert H. Berdo
James Magee, Jr.

March 16, 1971